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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/725,163	12/01/2003	James Henry Schumacher	45251-1001	1779

7590 08/10/2005

Jonathan Tyler, Esq.  
425 Park Avenue  
New York, NY 10022-3598

EXAMINER
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STASHICK, ANTHONY D

ART UNIT	PAPER NUMBER
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3728

DATE MAILED: 08/10/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

*Tala*

<b>Office Action Summary</b>	Application No.	Applicant(s)	
	10/725,163	SCHUMACHER, JAMES HENRY	
	Examiner	Art Unit	
	Anthony Stashick	3728	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-35 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-35 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>01162004</u> . | 6) <input type="checkbox"/> Other: ____.  |

## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-2, 4-9, 11-14, and 16-19 are rejected under 35 U.S.C. 102(b) as being anticipated by Laux 4,387,516. Laux '516 discloses all the limitations of the claims including the following: an insert 50 comprising a surface upon which a wearer's foot is placed (top surface of 50 facing the inside of the shoe upper when 50 is placed within a shoe); at least one visible symbol 60, 61, 62, 76 situated on the surface representing a desired placement of the wearer's foot; a material (see col. 2, lines 10-17) that forms at least a portion of the surface; the material is capable of producing a visible record of an actual placement of the wearer's foot (the terry cloth or other absorbent material would give impression of the user's foot); the visible record includes one or more markings associated with perspiration absorbed by the material (terry cloth will become a darker color when wet and has absorbed perspiration); the material is a synthetic, poromeric material (see col. 2, lines 10-17); the visible record includes a change of a portion of the surface from a first color to a second color (terry cloth will become a darker color when wet and has absorbed perspiration); the visible record includes an appearance on the surface of an image (surface will be wet or damp with perspiration that was absorbed by the terry cloth) ; the at least one visible symbol includes a form representing a desired placement of a toe (see lines 60, 61, 62 and 76); the insert surface being a layer (see Figures).

*Claim Rejections - 35 USC § 103*

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 20-21 23-26, 28-29 and 31-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Laux 4,387,516 as applied above in view of Dribbon 5,678,566. Laux '516 as applied above discloses all the limitations of the claims except for the upper. Dribbon '566 teaches that s shoe with an insert that indicates different conditions of a user's foot by change of color can have an upper attached to a sole with the indicating sole placed within the shoe upper. Therefore, it would have been obvious, to one of ordinary skill in the art at the time the invention was made, to place the insole of Laux'516 as applied above, inside a shoe with a sole and upper, as taught by Dribbon '566, to help fit the insole to the user's foot for the shoe in which the user is going to place the insole in. With respect to the method claims, the mere use of the insole of Laux '516 in a shoe such as Dribbon '566 would meet the limitations of those claims.

5. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Laux 4,387,516 as applied to claim.8 above in view of Marier et al. 5,994,245. Laux '516 as applied to claim 8 above discloses all the limitations of the claims except for the other two layers, one for providing stiffness and the other for providing air circulation. Marier et al. '245 teaches that an insole or insert in a shoe can be made up of multiple layers including a layer 4 for providing stiffness and a layer for providing air circulation 10. These layers further enhance the comfort of the shoe on

Art Unit: 3728

the user and helps in cushioning and protecting the user's foot from impacts of the shoe with the ground. Therefore, it would have been obvious, to one of ordinary skill in the art at the time the invention was made, to make the insert of Laux out of multiple layers, as taught by Marier et al. to aid in cushioning and protecting the user's foot when placed within the shoe during use.

6. Claims 27 and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over the references as applied to claims 20 and 28 above in view of Byrd D466,273. The references as applied to claims 20 and 28 teach all the limitations of the claims except the shoe being a child's shoe. Byrd '273 teaches that a child's shoe can have size indicators located thereon to easily see whether the shoe size is the correct shoe size for the child. Therefore, it would have been obvious to place the insert of the references as applied to claims 20 and 28 above in a child's shoe to verify the correct size for the child's foot when trying on the shoe.

7. Claims 3, 10, 22 and 30 are rejected under 35 U.S.C. 103(a) as being obvious over the references as applied to claims 1, 8, 20 and 28 above. The references as applied to claims 1, 8, 20 and 28 disclose all the limitations of the claims except for the material being unfinished leather. Since unfinished leather is a well-known material for making insoles and it is known that leather can absorb perspiration, it would have been obvious, to one of ordinary skill in the art at the time the invention was made, to make the upper layer of the insole out of leather for its well-known properties leading to comfort of the user's foot.

### ***Conclusion***

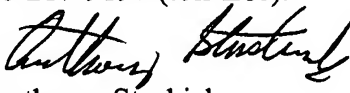
8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure and are cited on form 892 enclosed herewith.

Art Unit: 3728

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anthony Stashick whose telephone number is 571-272-4561. The examiner can normally be reached on Monday-Thursday 8:30 am to 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on 571-272-4562. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Anthony Stashick  
Primary Examiner  
Art Unit 3728

ADS